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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,902

03/12/2004

Jae Yeong Park

2080-3236

8316

7590

05/25/2006

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EXAMINER

LE, HOANGANH T

ART UNIT

PAPER NUMBER

2821

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/799,902

Applicant(s)

PARK, JAE YEONG

Examiner

HoangAnh T. Le

Art Unit

2821

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
Hoanganh Le  
Primary Examiner

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendment filed on May 15, 2006 is acknowledged.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Honjo (the US patent No. 5,404,581, of record).

The Honjo reference teaches in figures 2-4 an antenna system comprising:  
an antenna 31 for receiving a signal, a low noise amplifier 34 for amplifying a signal received through the antenna so as to minimize a noise generation, and a phase shifter 37 for controlling a phase of the amplified signal, wherein the antenna 31, the low noise amplifier 34, and the phase shifter 37 are formed on one high resistance substrate 1 .  
The high resistance substrate is preferably selected among a high resistance silicon substrate, a high resistance ceramic substrate, and a printed circuit board (PCB). The high resistance substrate is a substrate of two surfaces having signal electrodes for connecting upper and lower surfaces thereof (figure 2): The antenna 5 is one between a patch antenna and a slot antenna. The phase shifter is constituted with signal

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electrodes, ground electrodes, inductors respectively formed of the same conductive material, and an electron switch 32 and a capacitor connected to the signal electrodes. The inductor is formed as a strip line structure or a spiral structure by a micro electro mechanical system (MEMS) technique (figure 2). The electron switch is formed as a bare chip form that is connected to the signal electrodes by a bonding wire (figure 2). The electron switch further includes a polymeric protection material. The electron switch is formed at an etched part of the high resistance substrate after partially etching the high resistance substrate. The electron switch is formed as a bare chip form connected to the signal electrodes by a flip chip bonding technique. The low noise amplifier is formed as a bare chip form connected to the signal electrodes by a bonding wire (figure 2). The phase shifter is constituted with signal electrodes, ground electrodes, inductors respectively formed of the same conductive material, and an electron switch and a capacitor connected to the signal electrodes (figure 2).

### ***Response to Arguments***

5. Applicant's arguments filed May 15, 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "a smart antenna system and a method for fabricating an active smart antenna system" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the

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preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the word "high resistance" means "non-conductive or hardlyconductive" and a high quality factor inductor) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Honjo does not teach a high resistance substrate.

Examiner respectfully disagrees. Honjo does teach a high resistance substrate 1. Figure 2 shows the substrate 1 being a semi-insulation GaAs substrate, and since the substrate 1 is a semi-insulation GaAs substrate, the substrate 1 should be a high-resistance substrate (see Fujiwara et al (US Patent No. 6,781,246) col. 4, lines 5-7 and col. 5, lines 35-38).

The Fujiwara et al reference is cited to show that a GaAs substrate is a high resistance substrate. Since Honjo does show all claimed structure, including the high resistance substrate 1, the 102 (b) rejection is proper.

### ***Conclusion***

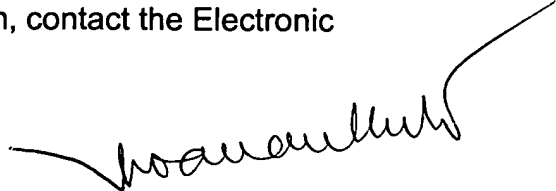
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HoangAnh T. Le whose telephone number is (571) 272-1823. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Hoanganh Le  
Primary Examiner